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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/895,510      | 06/29/2001  | Brian Rasmussen      | SUN-P6236           | 8236             |

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01/07/2004

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San Jose, CA 95113

EXAMINER

LABAZE, EDWYN

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |   |           |
|------------------------------|--------------------------------------|---|-----------|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/895,510 | <b>Applicant(s)</b><br>RASMUSSEN ET AL. |           |
|                              | <b>Examiner</b><br>EDWYN LABAZE      | <b>Art Unit</b><br>2876                 | <i>mw</i> |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Claims 1-16 and 23-25 are presented for examination.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-5 and 9-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Chan et al. (U.S. 6,588,673).

Re claims 1 and 9: Chan et al. discloses method and system in-line pre-production data preparation and personalization solutions for smart cards, which includes means of receiving identifying information for a non-activated [new card with no prior data or personal information in the chip controller] smart card 10 that is being used for the first time by a user (col.5, lines 39+); receiving manual authentication information for the user to whom the non-activated smart

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card 10 has been issued (col.7, lines 12-40); authenticating the user and the non-activated smart card 10 using the identifying information and the manual authentication information (col.8, lines 1+); obtaining a public key from the non-activated smart card (col.8, lines 18+); and issuing a digital certificate that is generated using the public key, wherein the non-activated smart card is activated upon receiving the digital certificate (col.3, lines 37-67; col.7, lines 18+; col.8, lines 20+; col.11, lines 28-41).

Re claims 2 and 10: Chan et al. teaches a system and method, wherein the manual authentication information comprises a user identifier and a password [a password could be interpreted as a personal identification number/PIN or any security code for accessing a file/account] (col.6, lines 60+).

Re claims 3 and 11: Chan et al. discloses a system and method, further comprising obtaining the digital certificate from a certificate authority (col.3, lines 37-67; col.7, lines 18+; col.8, lines 20+; col.11, lines 28-41).

Re claims 4 and 12: Chan et al. teaches a system and method, wherein the smart card is connected to a workstation (col.7, lines 12+).

Re claims 5 and 13: Chan et al. discloses a system and method, wherein the digital certificate is stored in at least one of the activated smart card and a workstation [wherein all cardholder's records are maintained in the database of the Host Security Module/HSM 114/124/134 throughout the pre-processing card personalization] (col.4, lines 28-48).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (U.S. 6,588,673) in view of Boroditsky et al. (U.S. 6,332,192).

Re claims 6-7: The teachings of Chan et al. have been discussed above.

Although Chan et al. discloses means of downloading [through a firmware module] the software application for per-personalization a [transaction, credit/debit, smart] card (col.8, lines 35+; col.12, lines 5+) but fails to teach the structural means for receiving a login request when the activated card is connected to a workstation, authenticating said card using the digital certificate, permitting login upon authentication of the card, further removing the card from the workstation after authentication and means of determining that the digital certificate has not been revoked.

Boroditsky et al. discloses generalized user identification and authentication system, which includes means for receiving a login request when the activated card is connected to a workstation, authenticating said card using the digital certificate, permitting login upon authentication of the card (col.3, lines 50-67), wherein the authenticating further connecting the smart card to a workstation or computer, removing the smart card from the workstation after the authenticating (col.13, lines 1-32).

In view of Boroditsky et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teaching of Chan et al. a system and method of verifying the authentication of each user before permitting access to the network and provide subsequent means of removing the card from the workstation after authentication for security purposes. Furthermore, such modification would allow the user to remove the digital identity or smart card from the workstation after the authenticating to prevent thief or access to stolen property by leaving or forgetting the digital identity or smart card into the terminal, which can be redeemed by anyone and would assure the security of personal information being in the wrong hands. Moreover, such modification would have been an obvious extension as taught by Chan et al., therefore an obvious expedient.

6. Claims 8, 14-16, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (U.S. 6,588,673) in view of Boroditsky et al. (U.S. 6,332,192).

Re claims 8, 14-16, and 23-25: The teachings of Chan et al. have been discussed above.

Chan et al. as modified above in claims 6-7 fails to show a method of determining that the digital certificate or smart card has not been revoked or disallowed.

Boroditsky et al. teaches a method, wherein the authenticating further comprises determining that the digital certificate has not been revoked or disallowed (col.11, lines 51+).

In view of Boroditsky et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to include a method of determining that the digital certificate has been revoked or disallowed into the teaching of Chan et al. in order to keep the user informed of the validity of the certificate. In addition, such modification would require a subroutine in the software program, which first check the domain/key on the card in

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comparison with a list of revoked/disallowed accounts stored in the database and if matched would end all process and inform the user that the card/digital certificate has been revoked or to see a service representative. Furthermore, if no match [for previous revoked cards] were found, the network/workstation would allow the user to login or have access to the computer resource by verifying/authenticating the smart card/digital identity, and also permit the user to remove the card or digital identity after authenticating the smart card or digital certificate. Moreover, such modification would have been an obvious extension of the teaching of Chan et al.

Re claim 25: Chan et al. discloses a system and method, wherein the digital certificate is stored in at least one of the activated smart card and a workstation [wherein all cardholder's records are maintained in the database of the Host Security Module/HSM 114/124/134 throughout the pre-processing card personalization] (col.4, lines 28-48).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tushie et al. (U.S. 5,889,941) discloses system and apparatus for smart card personalization.

Chan et al. (U.S. 6,233,683) teaches system and method for a multi-application smart card, which can facilitate a post-issuance download of an application onto the smart card.

Graham, Jr. et al. (U.S. 6,402,028) teaches integrated production of smart cards.

Sato et al. (U.S. 6,612,486) discloses smart card managing system.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (703) 305-5437 or (571) 272-2395, which will be effective as of January 15, 2004. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

el  
Edwyn Labaze  
Patent Examiner  
Art Unit 2876  
December 27, 2003



**THIEN M. LE**  
**PRIMARY EXAMINER**